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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,166	11/17/2003	Ting-Dong Zhang	WAX017-185360C	4088

7590 07/05/2005

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Philadelphia, PA 19103-2097

EXAMINER
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PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/715,166

**Applicant(s)**

ZHANG, TING-DONG

**Examiner**

JOHN PAK

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/702,011.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 07012005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Claims 10-17 are pending in this application.

The terminal disclaimer filed on 4/29/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,720,011 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, no obviousness type double patenting rejection shall be made over U.S. Patent No. 6,720,011.

It is noted that preliminary amendments to the claims and specification were filed on 11/17/2003. The filing date of this application is also 11/17/2003. For applications filed before 9/21/2004, preliminary amendments are **not** treated as part of the original disclosure. 37 CFR 1.115. Therefore, applicant's preliminary amendments of 11/17/2003 cannot be treated as part of the original disclosure, because (1) this application was filed before the effective date (9/21/2004) of amended 37 CFR 1.115, and (2) the preliminary amendment was not referenced in the oath/declaration.

Further, applicant is advised that the specification amendments filed on 11/17/2003 are not in compliance with the rules for amending the specification. New rules for amending the specification, effective 7/30/2003, do not permit sentence insertions of the type applicant instructs in the amendments of 11/17/2003. Therefore, said specification amendments are **not entered**.

Claims 10-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 10 and 12 require preparing an aqueous solution consisting of arsenic trioxide and at least one pH-buffering agent selected from the group consisting of hydrochloric acid, alkali hydroxide, and carbonate solutions. There is absolutely no descriptive support for a pH buffering agent in general or the specific agents as a pH buffering agent.

Therefore, the originally filed disclosure failed to convey the skilled artisan that the aqueous solution consisting of arsenic trioxide is to also include at least one pH-buffering agent selected from the group consisting of hydrochloric acid, alkali hydroxide, and carbonate solutions. Disclosure in an application that merely renders the later-claimed (by amendment) invention obvious is not sufficient to meet the written description requirement of 35 USC 112, first paragraph. Lockwood v. American Airlines, 41 USPQ 2d 1961, 1966 (Fed. Cir. 1997). The claims thereby fail to comply with the written description requirement of 35 USC 112, first paragraph.

It is noted for the record that the Examiner talked to Mr. Zielinski on 2/9/2005 and requested a terminal disclaimer over U.S. Patent No. 6,720,011 to advance prosecution. At that time, the Examiner performed a brief review of this application, and made an

initial determination that the only issue, in view of the previous determination of patentability of similar claims in U.S. Patent No. 6,720,011, was a double patenting issue over said patent. The Examiner informed Mr. Zielenski of this initial impression of the claims in this application. However, upon a full review of the case at this time, the Examiner discovered the new matter issue, which has been set forth above. Therefore, the Examiner regrets that his initial discussion of the claims, prior to a full examination, did not spot the new matter issue until now.

US Patent Application Publication 2004/0126434 is cited to further show the state of the art.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

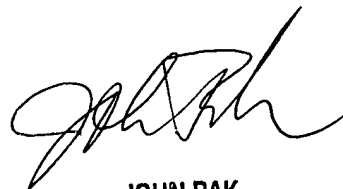
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Art Unit: 1616

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600

Continuation of Substance of Interview including description of the general nature of what was discussed: Examiner Pak called Mr. Zielinski to suggest filing a terminal disclaimer over the above noted patent. The Examiner informed Mr. Zielinski that an initial review of the case indicated double patenting to be the only issue in this case, in view of the previous determination of patentability of similar claims in U.S. Patent No. 6,720,011.